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In re Application of :
AKHAVE et al. :
U.S. Application No. 09/647,752 : DECISION ON PETITION
PCT No.: PCT/US98/25875 :
Int. Filing Date: 07 December 1998 :
Priority Date: 08 December 1997 :
Attorney Docket No.: 310048-347-US :
For: CONTROLLED DROPLET FORMED
LAYERED STRUCTURES

This decision is in response to applicants' "Petition for Late Acceptance of Declaration or in the Alternative to Revive Based on Unintentional Abandonment of Application," which is being treated as a Petition under 37 CFR 1.137(b) and Petition under 37 CFR 1.47(a) filed 31 May 2002. The requisite \$1280 petition fee for the filing of a petition under 37 CFR 1.137(b) and the requisite \$130 for a petition under 37 CFR 1.47(a) have been submitted. The above-captioned national stage application became abandoned on 05 June 2001 for failure to submit an acceptable oath or declaration with the time period set forth in the "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) mailed 04 January 2001.

BACKGROUND

On 07 December 1998 applicant filed international application PCT/US98/25875 which claimed a priority date of 08 December 1997. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 08 June 2000.

On 04 October 2000, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee; a copy of the international application; an information disclosure statement; and a petition seeking revival under 37 CFR 1.137(b). The petition to revive under 37 CFR 1.137(b) was granted in a decision dated 21 December 2000.

On 04 January 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

On 31 May 2002, applicant filed the present petition under 37 CFR 1.137(b) and 37 CFR 1.47(a).

DISCUSSION

The above-identified application was abandoned on 05 June 2001 for failure to respond to the Notification of Missing Requirements mailed 04 January 2001.

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Applicants have satisfied Items (2)-(4).

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicant submitted the present Petition Under 37 CFR 1.47(a). Under the present circumstances, in order for the response requirement, item (1) above, to be satisfied, the petition to accept the application without the signature of joint-inventor Ghanshyam H.. Popat must be grantable.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Applicant has provided items (1) and (3) under 37 CFR 1.47(a).

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.

The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicant has not satisfied the item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the instant application papers, including the specification, claims, and drawings to Ghanshyam H.. Popat. Petitioner has included "Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor" which states that Ghanshyam H.. Popat refuses to execute the Declaration. However, a review of the "Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor" reveals that the refusal by Ghanshyam H.. Popat is not for the above-identified application, but for U.S. application no. 09/071,785. Therefore, petitioner has not provided documentary evidence to support the refusal or the attempt for the instant application (09/647,752).

As to Item (4), a review of the declaration filed on 31 May 2002 reveals that the declaration is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration filed with the petition includes a duplicate sheet of page 2 of 2. It is unclear if the inventors were presented with only page 2, in which case the execution would be improper, or if they were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document filed 19 June 2002, which is improper. (See MPEP 201.03.)

For the reasons stated above, it would not be appropriate to accept the application without the signature of Ghanshyam H.. Popat under 37 CFR 1.47(a) at this time.

Therefore, the petition to revive under 37 CFR 1.137(b) cannot be granted at this time.

CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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